

REMARKS

Claims 1, 2, 3, 4, 5, 7, 12, and 23-38 are pending in the application. All of the pending claims are currently amended. Claims 6 and 22 were canceled in the amendment of October 4, 2007 without prejudice. In the Official Action of August 27, 2007, claims 1-2, 4-7, 12 and 22-26 were objected to as containing non-elected subject matter. Claim 1 was objected to as containing typographical errors. Claims 23 and 24 were objected to as being substantial duplicates of the claims from which they depend. Claims 7 and 22 were rejected under 35 U.S.C. §112, first paragraph for failing to meet the written description requirement.

Claim 1

In the amendment of October 4, 2007, claim 1 was amended in accordance with the Examiner's suggestions: the phrase "with the following provisos", which was intended to be recited but because of a typographical error was erroneously omitted from the amendment of June 14, 2007, was added to claim 1 in a manner that encompasses both provisos (a) and (b). Within proviso (b), numerals (v), (vi), (vii) and (viii) were been deleted. Moreover, references to heterocyclic substituents within the definition of G were deleted; thus the amendment of October 4, 2007 effectively eliminated such substituents from all other claims in the application. The present amendment deletes the recitation that the definition of formula I includes prodrug esters. The present amendment also deletes the recitation that the definition of formula I includes stereoisomers thereof, inasmuch as it is believed that this recitation is superfluous, the claims inherently including any and all individual stereoisomers or mixtures thereof where the stereochemistry at a given stereogenic carbon is not specified. It is submitted that claim 1 is in condition for allowance.

Claims 5, 6, 7, 23 and 24

In the Official Action of August 27, 2007, the Examiner, citing MPEP 706.03(k), stated that claims 23 and 24 are "substantial duplicates of the claims from which they depend". As explained in the response of October 4, 2007, Applicant disagrees. Claims 23 and 24 each depend from claim 1, and each recite a specific compound that falls within the genus of claim 1. Inasmuch as the genus recited in claim 1 includes compounds other than the compounds recited

in each of claims 23 and 24, claims 23 and 24 do not “cover the same thing” as claim 1, and cannot reasonably be characterized as being “substantially duplicates” of claim 1 from which they depend.

Applicant notes that the Examiner referred in the objection to claims 5 and 7. Applicant therefore wonders if the Examiner meant to state that claims 23 and 24 are “duplicates” of claims 5 (or 6) and 7 respectively. However, if this is the case, then Applicant submits that the cited MPEP section is inapplicable, for the same reasons recited above: claims 5 (and 6) and 7, prior to the amendments of October 4, 2007, recited groups of compounds that included compounds other than the compounds recited in claims 23 and 24, and therefore claims 23 and 24 did not “cover the same thing” as claims 5 and 7, and could not reasonably be characterized as being “substantially duplicates” of claims 5 and 7.

For reasons unrelated to the objection to claims 23 and 24 on the basis of MPEP 706.03(k), Applicant in the amendment of October 4, 2007 (i) amended claim 5 to recite a single compound from the group of compounds originally recited in this claim, (ii) canceled claim 6, (iii) amended claim 7 to recite a pair of compounds from the group of compounds originally recited in this claim, and (iv) added new claims 27-38 that recite individual compounds. Most of claims 27-38 recite compounds that were previously recited in one of the groups of compounds listed in claim 5 or in claim 7. Support for each of claims 27-38 can be found in the specification, *inter alia* in the examples, as follows:

Claim	Example	Claim	Example	Claim	Example
27	39	31	35	35	51
28	18	32	37	36	61
29	20	33	41	37	66
30	22	34	2	38	67

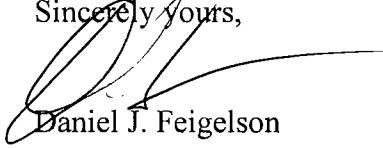
Inasmuch as each of claims 5, 7, 23, 24 and 27-38 is directed to a single compound or a pair of compounds, each of which falls within the genus of claim 1, it cannot be said that any of these claims is a “substantial duplicate” of claim 1 from which it depends, or that any of these claims are “substantial duplicates” of one another. (With respect to the compound appearing on the right in claim 7 and the compound recited in claim 24, the Examiner’s attention is drawn to

the fact that these compounds differ in the stereochemistry at the carbon bearing the hydroxyl group.) It is thus submitted that even if it assumed *arguendo* that the objection on the basis of MPEP 706.03(k) was proper, this objection has been mooted in view of the amendments effected in the claims on October 4, 2007.

Furthermore, with the cancellation of claim 22, and the re-writing of claim 7 to once again depend from claim 1, it is respectfully submitted that the rejection under 35 U.S.C. §112, first paragraph was obviated.

In the present amendment, each of the claims has been amended to clearly recite that it also encompasses pharmaceutically acceptable salts. Support for these amendments can be found, for example, at page 6, lines 18-19, and page 29, line 14 to page 30, line 17.

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. Allowance of the application is respectfully requested.

Sincerely yours,

Daniel J. Feigelson
Applicants' representative